

Appl. No. 09/518,697
Reply to Office Action of February 17, 2004

Attorney Docket No. 28207.3
Customer No. 27683

REMARKS

Claims 1-10, 12, 15-19, 21-38, 41-44 are pending in the application. Claims 1, 4, 5, 6, 12, 15, 21, 23, 26, 28, 33, and 35 have been amended. Claim 20 has been cancelled. Claims 43 and 44 have been added. Reconsideration of this application in light of the above amendments and the following remarks is requested.

Allowable Subject Matter

Claim 6-10, 20-21, 23, and 26 are objected to as being dependent upon a rejected base claim. Claims 6, 26, and 33 have been rewritten in independent form and thus are in condition for allowance. Claim 15 has been amended to include the limitation from claim 20 and thus is also in condition for allowance. Claims 7-10, 16-19, 21-27, 34, and 36 depend from and further limit claims 6, 15, 26, and 33 and therefore are also in condition for allowance.

Rejections of the Information Disclosure Statement

The information disclosure statement filed June 20, 2000 has been amended to provide dates for items AO-AR and BO-BR. A supplemental information disclosure statement has been filed separately, and a copy of the 1449 Form is enclosed for the Examiner's reference at Exhibit A. The dates for items AP-AR and BO-BR reflect the date the Applicant received the material. Further information such as the original publication dates of the items is unknown and is not readily available to the Applicant. Applicant believes that this constitutes a complete reply in conformance with the requirements of 37 CFR 1.105 and M.P.E.P 704.12(b).

Rejections Under 35 U.S.C. §101

Claims 15-27 stand rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter. Claim 15, from which claims 16-27 depend, has been amended to delete the apparatus limitation. Therefore, claim 15 does not mix statutory classes, and the rejection under 35 U.S.C. §101 should be withdrawn.

Appl. No. 09/518,697
Reply to Office Action of February 17, 2004

Attorney Docket No. 28207.3
Customer No. 27683

Rejections Under 35 U.S.C. §112

Claims 1-10, 12, 15-38, and 41-42 stand rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 15-27: Claim 15, from which claims 16-27 depend, has been amended to delete the apparatus limitation. Therefore, claim 15 does not mix statutory classes, and the rejection under 35 U.S.C. §112 as to claims 15-27 should be withdrawn.

Claims 4 and 5: The transitional phrasing of claims 4 and 5 has been amended to alleviate confusion, and therefore the rejection under 35 U.S.C. §112 as to claims 4 and 5 should be withdrawn.

Claims 1-10, 12, 28-38, and 41-42: The term "accurately," which the Examiner has deemed ambiguous, has been deleted from independent claims 1 and 28. Therefore, the rejection under 35 U.S.C. §112 as to independent claims 1 and 28 and dependent claims 2-10, 12, 29-38, and 41-42, which depend from and further limit claims 1 and 28, should be withdrawn.

Claims 12, 25, and 38: The Examiner has stated that claims 12, 25, and 38 which recite "wherein said saved results are provided to said user in the form of a graph" are not clear insofar as the information to be displayed in the graph. The Applicant contends that this limitation is clear in light of the specification. The Examiner's attention is, respectfully, drawn to Fig. 6b which depicts one example of the type of information that may be displayed in a graph. Page 32, lines 1-5 of the written description also include an example of the type of information that may be graphed. Because the limitations found in claims 12, 25, and 28 are clear, the rejection under 35 U.S.C. §112 as to these claims should be withdrawn.

Rejections Under 35 U.S.C §102

Claims 1, 12, 15-17, 22, 24-25, 27-28, and 35 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,197,120 to Saxton ("Saxton"). The PTO provides in MPEP §2131 that,

Appl. No. 09/518,697
Reply to Office Action of February 17, 2004

Attorney Docket No. 28207.3
Customer No. 27683

"to anticipate a claim, the reference must teach every element of the claim." Therefore, the Saxton patent must teach all elements of the rejected claims. However, with respect to independent claims 1 and 28, the Saxton reference does not appear to teach, "the parametric objects describe information sufficient for assembly of a complete building model for the building's construction." Therefore, the rejection is not supported by the Saxton reference and should be withdrawn as to independent claims 1 and 28. Claims 2-5, 12, 29-38, 41, and 42 depend from and further limit claims 1 and 28 and therefore are in condition for allowance.

Independent claim 15 has been amended to include the limitations from allowed claim 20, and therefore, as described above, claim 15 and its dependent claims 16-19 and 21-27 are in condition for allowance.

Rejections Under 35 U.S.C. §103(a)

Claims 1-3, 12, 15-17, 22, 24-25, 27-30, and 33-38 stand rejected under 35 U.S.C. § 103(a) as being anticipated by the publication entitled "A Feature-Based, Parametric Modeling System for CAD/CAPP/CAM Integrated System," written by Li Hailong et al. ("the Li reference") or the publication, "Parametric Model: A Conceptual Framework for Geometric Modeling Databases," written by Deepa Krishnan, et al. ("the Krishnan reference") in view of the Saxton patent. As the PTO recognizes in MPEP §2143, "[t]o establish a prima facie case of obviousness, . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to independent claims 1 and 28 because even when combined, the references do not teach the claimed subject matter.

Neither the combination of the Li reference with Saxton nor the combination of the Krishnan reference with Saxton appears to teach, "the parametric objects describe information sufficient for assembly of a complete building model for the building's construction" as is recited in independent

Appl. No. 09/518,67
Reply to Office Action of February 17, 2004

Attorney Docket No. 28207.3
Customer No. 27683

claims 1 and 28. Therefore it is impossible to render the subject matter of claims 1 and 28 as a whole obvious. As the Examiner has recognized, neither the Li nor the Krishnan references disclose a complete building model for the building's construction. The addition of Saxton, as described above, does not remedy this defect. Thus, a *prima facie* case of obviousness clearly cannot be met, and the rejection under 35 U.S.C. §103 should be withdrawn. Claims 2-5, 12, 29-38, 41, and 42 depend from and further limit claims 1 and 28 and therefore are in condition for allowance.

Independent claim 15 has been amended to include the limitations from allowed claim 20, and therefore, as described above, claim 15 and its dependent claims 16-19 and 21-27 are in condition for allowance.

New Claims

Claims 43 and 44 have been added to the application. Each new claim further describes the information sufficient for assembly of a complete building model for the building's construction.

Appl. No. 09/518,697
Reply to Office Action of February 17, 2004

Attorney Docket No. 28207.3
Customer No. 27683

Conclusion

It is respectfully submitted that independent claims 1-10, 12, 15-19, 21-38, 41-44 are in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

**David L. McCombs
Registration No. 32,271**

Dated: _____
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 214/651-5533
Facsimile: 214/200-0853

67485 1.DOC

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

Gayle Conner